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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,943	09/04/2003	Alan John Sullivan	2069.037US1	7023
21186 7590 04/21/2009 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER LANGHNOJA, KUNAL N				
ART UNIT 2427		PAPER NUMBER		
MAIL DATE 04/21/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/655,943

Applicant(s)

SULLIVAN, ALAN JOHN

Examiner

KUNAL LANGHNOJA

Art Unit

2427

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/11/2009 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 7-15 rejected under 35 U.S.C. 102(e) as being anticipated by Lupulescu et al (United States Patent Application Publication 2003/0030751).

Regarding claim 7, Lupulescu teaches "a terminal [15] for creating a transaction token," (Figure 1) including

"an interface to a client secure device, and arranged to create a transaction token incorporating a first code (i.e. username/password), the first code uniquely identifying a subscriber secure device (i.e. based on username/password user is allow to purchase events for subscriber's television system), and a user interface for entering the first code (i.e. keypad), and wherein the terminal is arranged to create the transaction token from the entered first code in co-operation with the client secure device." (Figures 1 and 2; paragraphs 0028, 0036 and 0040-41)

Regarding claim 8, Lupulescu teaches "a user interface (i.e. keypad) for entering a second code (i.e. event), identifying a product to be bought, wherein the terminal is arranged to incorporate the second code in the transaction token in co-operation with the client secure device (i.e. request includes channel, event, smart card and ID)." (paragraphs 0040-41)

Claim 9 is rejected wherein "the terminal is arranged to include a digital signature with the transaction token in co-operation with the client secure device." (paragraphs 0036 and 0040-41)

Claim 10 is rejected wherein "the terminal includes a user interface for entering a personal identification code, and is arranged to generate the digital signature using the personal identification code in co-operation with the client secure device." (paragraphs 0036 and 0040-41)

Claim 11 is rejected wherein "the terminal [15] includes a user interface for entering further details of the transaction, and is arranged to incorporate the entered details in the token in co-operation with the client secure device." (Figures 1 and 2; paragraphs 0036 and 0040-41)

Claim 12 is rejected wherein "establish a communications link with an arbitrator system, and to transfer the token through the communications link to the arbitrator system." (Figures 1 and 2; paragraph 0036 and 0040-41)

Claim 13 is rejected wherein "the terminal is arranged to receive a confirmation of the transaction from the arbitrator system, and has the capability of indicating receipt of the confirmation to the user." (Figure 2; Paragraph 0041)

Claim 14 is rejected wherein "a client secure device, suitable for use in a terminal according to claim 7, and arranged to create at least part of the transaction token." (Figures 1 and 2; paragraph 0036 and 0040-41)

Claim 15 is rejected wherein "a computer program, including a plurality of computer-readable instructions, when executed by a machine, cause the machine to perform the method wherein when the computer program is run on a terminal including a client secure device and a user interface, to provides the system including the terminal and the client secure device with the functionality of a terminal according to claim 7." (Paragraphs 0028-29, 0036 and 0040-41)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak et al (United States Patent Application Publication 2003/0097655), in view of Florin et al (United States Patent 5,621,456), further in view of Lupulescu et al (United States Patent Application Publication 2003/0030751).

Regarding claim 1, Novak teaches "a system for effecting a transaction," including a head-end [110], a communications network [101], and a subscriber secure device [410], a receiver [102], capable of receiving digital information (i.e. digital signals), including content data from the head-end [110] through the network [101], and of making the content data available to a user on a display device [104], which receiver further includes an interface [305] to the subscriber secure device [410], the first code uniquely identifying the subscriber secure device [410]. (Figures 1 and 4; Paragraphs 0052-53, 0074 and 0082) However, the reference is unclear with respect to "wherein the receiver is programmed to make a first code available on the display device, a client secure device, and a terminal having a user interface for entering the first code, wherein the terminal is arranged to create a transaction token from the entered first code in co-operation with the client secure device, wherein the terminal includes an interface to the client secure device."

In similar field of endeavor, Florin et al teaches "wherein the receiver is programmed to make a first code [425] available on the display device [180]." (Figures

1, 40 and 41; Col.23 lines 25-55) Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Novak for the purpose of allowing user to enter the personal Identification number in order to securely order program/content.

In similar field of endeavor, Lupulescu et al teaches "a client secure device, and a terminal [15] having a user interface (Figures 3 and 4) for entering the first code (i.e. username/password), wherein the terminal is arranged to create a transaction token from the entered first code in co-operation with the client secure device, wherein the terminal includes an interface to the client secure device." (Figures 1 and 2; Paragraphs 0028, 0036 and 0040-41) Therefore, it would have been obvious one to one of ordinary skill in the art at the time the invention was made to modify Novak et al and Florin et al, the combination for the purpose of allowing users to order content using wireless device without the necessity of having a PC/permanent land-line telephone connection to the subscriber's television receiver (Lupulescu: Paragraph 0009).

Regarding claim 2, Novak teaches "a method of enabling a transaction," in a system including a head- end [110], a communications network [101], and a receiver [102], the method comprising:

receiving digital information (i.e. digital signals) at the receiver [102], the digital information including content data, wherein the digital information is received from the head-end [110] through the network [101], making the content data available to the user wherein the receiver [102] further includes an interface [305] to the subscriber secure device [410]. (Figures 1 and 4; paragraphs 0052-53, 0074 and 0082) However, the

reference is unclear with respect to "making a first code available to the user on the display device of the receiver, receiving the first code at a terminal and creating a transaction token using the first code and in co-operation with a client secure device, wherein the first code uniquely identifies the secure subscriber device, making the content data available to the user wherein the receiver further includes an interface to the subscriber secure device."

In similar field of endeavor, Florin et al teaches "making a first code [425] available to the user on the display device [180] of the receiver." (Figures 1, 40 and 41; Col.23 lines 25-55) Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Novak for the purpose of allowing user to enter the personal Identification number in order to securely order program/content.

In similar field of endeavor, Lupulescu et al teaches "receiving the first code (i.e. username/password) at a terminal [15] and creating a transaction token using the first code and in co-operation with a client secure device, wherein the first code uniquely identifies the secure subscriber device." (Figures 1 and 2; Paragraphs 0028, 0036 and 0040-41) Therefore, it would have been obvious one to one of ordinary skill in the art at the time the invention was made to modify Novak et al and Florin et al, the combination for the purpose of allowing users to order content using wireless device without the necessity of having a PC/permanent land-line telephone connection to the subscriber's television receiver (Lupulescu: Paragraph 0009).

Regarding claim 3, Novak teaches everything claimed (see claim 2), however the reference is unclear with respect to “a second code, identifying a product to be ordered, and included in the content data, is made available to the user on the display device.”

In the similar field of endeavor, Florin teaches “a second code (i.e. Jeff’s world), identifying a product to be ordered, and included in the content data, is made available to the user on the display device [180].” (Figures 40, and 41; Col. 23, lines 25-55) Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify by specifically adding “a second code, identifying a product to be ordered, and included in the content data, is made available to the user on the display device” for the common knowledge purpose of user-friendly mechanism for consumers to view, record, and play back TV and pay-per-view programs as well as control A/V home entertainment devices using a remote control device.

Claim 4 is rejected wherein “a computer program, when run on a system, including a receiver and a subscriber secure device, connected to the receiver through an interface, to enable the system to execute a method according to claim 2.” (Paragraphs 0052-53, 0074, 0079 and 0082)

Claim 5 is rejected for the same reasons set forth in the rejection of claims 1- 2.

Claim 6 is rejected wherein “the subscriber secure device [410] includes a further identification code, and is arranged to calculate the first code (i.e. user identification) by encrypting the further identification code.” (Paragraph 0074)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KUNAL LANGHNOJA whose telephone number is 571-270-3583. The examiner can normally be reached on M-F 9 A.M- 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on 571-272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KL

/Scott Beliveau/

Supervisory Patent Examiner, Art Unit 2427